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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,031	11/15/2006	Ralf Wilbert	016906-0517	9121
22428 7590 06/23/2008 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				
EXAMINER				
MEYER, JACOB B				
ART UNIT		PAPER NUMBER		
3618				
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06/23/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/583,031

**Applicant(s)**

WILBERT, RALF

**Examiner**

JACOB MEYER

**Art Unit**

3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 March 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.  
4a) Of the above claim(s) 1-11 and 16-18 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 12-15 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 15 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date 06/15/2008  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group II, claims 12-15 in the reply filed on 03/20/2008 is acknowledged. Therefore, claims 1-11 and 16-18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 06/15/2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 12-14 are rejected under 35 U.S.C. 102(c) as being anticipated by Sanada et al (US Pub. No. 2003/0075305 A1).

Regarding claim 12, Sanada et al teaches an arrangement for fixing a heat exchanger (Figure 1, Element 100), particularly a cooling module in a motor vehicle, preferably at four, two upper (Figure 1, Element 160) and two lower (Figure 1, Element 170), fixing points, with interengaging fixing means being provided on the heat exchanger and retaining means being provided on the motor vehicle, characterized in that at least one fixing means, preferably the two upper fixing means, are designed as an elastomeric bearing (Figure 2, Element 160 and paragraph [0017]), and at least one retaining means, preferably the two upper retaining means, are designed as a screw bolt (Figure 1, Element 11) with a displacement limit stop (i.e., the flange head of Element 11 abutting against Element 150), the screw bolt being supported in an essentially strain-free manner (wherein the screw bolt is essentially strain free inasmuch as the bolt does not substantially deform from compressive or shearing forces) firstly on the motor vehicle and secondly on the elastomeric bearing (Figures 1 and 2).

Regarding claim 13, Sanada et al teaches the arrangement as claimed in claim 12, the at least one screw bolt (Figure 2, Element 11) is screwed into a cross member (Figure 2, Element 10) arranged above the heat exchanger and is restricted in its screw-in depth by the displacement limit stop (Figure 2).

Regarding claim 14, Sanada et al teaches the arrangement as claimed in claim 12, wherein the lower retaining means (Figure 1, Element 170) are arranged on a lower cross member (, and in that the heat exchanger or more precisely the cooling module is supported

Art Unit: 3618

between the two cross members in a manner very substantially free from compressive stress (Figure 1, paragraph [0020]).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanada et al (US Pub. No. 2003/0075305 A1), further in view of Hasselmeyer et al (DE 40 30 720 A1).

Sanada et al teaches the invention except for the arrangement as claimed in claim 12, wherein at least one screw bolt is designed for fixing components, with a screw head, a screw-in thread, a stem and an end surface and with a depression for the insertion of a tool which has an engagement height h, wherein a longitudinal channel of length L1 emerging at the screw head and in the end surface is arranged in the screw bolt and a pin of length L2 which is moveable in the longitudinal direction is arranged in the longitudinal channel, L2 being larger than L1 by the

amount  $\Delta L$ , and  $\Delta L$  corresponding to the engagement height  $h$  of the tool head. Hallelmeyer et al discloses at least one screw bolt designed for fixing components, with a screw head (Figure 1, Element 2), a screw-in thread (Figure 1, exterior of Element 3), a stem (Figure 1, Element 3) and an end surface and with a depression (Figure 1, Element 11) for the insertion of a tool which has an engagement height  $h$ , wherein a longitudinal channel (Figure 1, Element 4) of length  $L1$  emerging at the screw head and in the end surface is arranged in the screw bolt and a pin (Figure 1, Element 5) of length  $L2$  which is moveable in the longitudinal direction is arranged in the longitudinal channel,  $L2$  being larger than  $L1$  by the amount  $\Delta L$ , and  $\Delta L$  corresponding to the engagement height  $h$  of the tool head. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the screw bolt of Hasselmeier et al in the mounting configuration of Sanada et al since where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)).

Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at 1396. Accordingly, since the applicant[s] have submitted no persuasive evidence that the combination of the above elements is

uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a) because it is no more than the predictable use of prior art elements according to their established functions resulting in the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Andritter, Takahashi, Ohki, Enomoto et al, Isobe, Ikuta et al, Murio et al, and Hiramoto disclose heat exchanger mounting configurations that may be of interest to Applicant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JACOB MEYER whose telephone number is (571)270-3535. The examiner can normally be reached on Monday - Friday 9am to 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Ellis can be reached on 571-272-6914. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3618

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher P Ellis/  
Supervisory Patent Examiner, Art Unit  
3618

/J. M./  
Examiner, Art Unit 3618  
06/17/2008